

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: FORSSELL et al.
Title: METHOD AND ARRANGEMENT
FOR TRANSFERRING
INFORMATION IN A PACKET
RADIO SERVICE
Appl. No.: 10/699,162
Filing Date: 10/31/2003
Patent No.: 7,564,784
Grant Date: 7/21/2009
Examiner: Kevin D. Mew
Art Unit: 2416
Confirmation 1603
Number:

**RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT UNDER 37 C.F.R. §1.705**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully renew their request for reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent. The USPTO indicated in the letter mailed June 22, 2009 (copy attached as Exhibit A), that a decision on the Applicants' initial request was being held in abeyance until after the actual patent date. As noted, the patent issued on July 21, 2009, as U.S. Patent No. 7,564,784.

The Patent Office determined that the patent was entitled to 872 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the

PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 1287 days PTA, as shown on the attached sheet (Exhibit B), which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	1378 days
(b) Total Applicant delay:	91 days
Final PTA Determination:	1287 days

Applicants therefore respectfully request that the patent be accorded 1287 days PTA.

The patent is not subject to a terminal disclaimer.

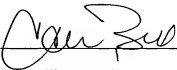
Because this is a renewed request, Applicants do not believe that any fee is due, the fee having been paid with the Applicants' original request on January 21, 2009. However, if a fee is due, and should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date September 11, 2009

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (608) 258-4263
Facsimile: (608) 258-4258

By  _____
Callie M. Bell
Attorney for Applicant
Registration No. 54,989



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

FOLEY & LARDNER LLP
150 EAST GILMAN STREET
P.O. BOX 1497
MADISON WI 53701-1497

MAILED

JUN 22 2009

OFFICE OF PETITIONS

In re Application of	:	
Forssell et al.	:	EXHIBIT A
Application No. 10/699,162	:	ON APPLICATION FOR
Filed: October 31, 2003	:	PATENT TERM ADJUSTMENT
Atty Docket No. 088245-1332	:	

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705 filed January 21, 2009. Applicants request that the patent term adjustment be increased from 816 days to 1231 days. Relying on Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), applicants request this correction on the basis that the Office will take in excess of three years to issue this patent (and considering the filing of a Request for Continued Examination on August 14, 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness of

any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was first filed in this application on August 14, 2008.

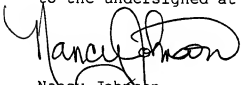
The determination of the patent term adjustment at the time of the mailing of the notice of allowance remains eight hundred sixteen (816) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) (as well as, 1.702(b)) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

CLOSE WINDOW

ADD CASES SELECT BASE

Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 088245-1332
 Application Number: 10/699162
 Patent Number: N/A

EXHIBIT B

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	10/31/2003	0		
Edit Delete	Notice to File Missing Parts	02/04/2004	96		
Edit Delete	Response to Notice to File Missing Parts	03/01/2004	122		
	14 month From Application date	12/31/2004	427		
	3 Year Period Starts	10/31/2006	1,096		
Edit Delete	Non-Final Office Action	06/26/2007	1,334	(907)	
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	09/24/2007	1,424		
Edit Delete	Final Office Action	12/19/2007	1,510		
Edit Delete	Final Office Action Response Received at PTO	01/17/2008	1,539		
Edit Delete	Advisory Action	02/12/2008	1,565		
	Final Office Action + 3 months	03/19/2008	1,601		
Edit Delete	Notice of Appeal Received at PTO	06/18/2008	1,692		91
Edit Delete	Notice of Appeal Received at PTO	06/18/2008	1,692		
Edit Delete	Request For Continued Examination (including amendment)	08/14/2008	1,749	(653) 1322	
	3 Year Period Stopped	08/14/2008	1,749		
Edit Delete	Notice of Allowance	10/29/2008	1,825		
Edit Delete	Issue Fee Paid	01/26/2009	1,914		
	Issue Fee Paid + 4 months	05/26/2009	2,034		
Edit Delete	Patent Grant Date	07/21/2009	2,090	56	
			Totals:	1,378	91
			PTA:	1,287	

Created and maintained by
FOLEY
 FOLEY & LARDNER LLP

Version: 3.02.05

LOGIN: Linda Anderson

IP: 10.24.4.21

Foley & Lardner LLP